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ON PETITION

In re Application of  
Shotaro Yamaguchi  
Application No. 09/727,769  
Filed: December 4, 2000  
Attorney Docket No. Q62106

This is a decision on the petition under 37 CFR 1.78(a)(3), filed November 7, 2002, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of prior-filed nonprovisional Application No. 09/324,910, filed June 3, 1999,

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;<sup>1</sup>
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

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<sup>1</sup> Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS)) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

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The instant pending application was filed on December 4, 2000 and was copending with the above-noted, prior-filed nonprovisional application, at the time of filing, for which priority is claimed. A reference to the above-noted, prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title which was filed concurrently with the instant petition under 37 CFR 1.78(a)(3).

The reference to the above-noted, prior-filed nonprovisional application was not included in the manner specified in 37 CFR 1.78(a)(2) (i.e., in an ADS or in an amendment to the first sentence following the title of the specification) or filed within the period specified in 37 CFR 1.78(a)(2)(ii).

A reference to add the above-noted, prior-filed application on page one following the first sentence of the specification has been included in an amendment filed on November 7, 2002. However, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior application. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35 U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The court specifically stated:

Section 120 merely provides a mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, *supra* at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a substitute amendment deleting the incorporation by reference statement is required.

**In order to expedite consideration, petitioner may wish to submit the substitute amendment by facsimile transmission to the number indicated below and to the attention of Karen Creasy .**

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Further correspondence with respect to this matter should be addressed as follows:

By mail: U.S. Patent and Trademark Office  
P.O. Box 2327  
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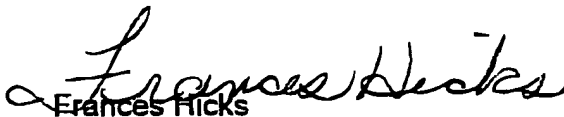
OR

Commissioner for Patents  
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By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23  
2201 South Clark Place  
Arlington, VA 22202

Any questions concerning this matter may be directed to Karen Creasy  
At (703) 305-8859.



Frances Hicks  
Lead Petitions Examiner  
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Date	December 12, 2002		
To	Frances Hicks, Lead Petitions Examiner, Office of Petitions		
Fax	703 308-6916		
From	Susan J. Mack, Esq.		
Subject	Substitute Amendment		
Our Ref	Q62106	Appln No	09/727,769
Conf No	5479	Inventors	Shotaro YAMAGUCHI
Pages	<u>5</u> (including cover sheet)		

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This fax filing includes:

1. This cover sheet
2. Substitute Amendment (with copy of Decision on Petition)

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CERTIFICATION OF FACSIMILE TRANSMISSION

PETITIONS OFFICE

Sir/Madam:

I hereby certify that the above identified correspondence is being facsimile transmitted to Francis Hicks, Lead Petitions Examiners, Office of Petitions, U.S. Patent and Trademark Office on December 12, 2002 at 703 308 6916.

Respectfully submitted,

A handwritten signature in cursive script that reads 'Susan J. Mack'. Below the signature, the name 'Susan J. Mack' is printed in a standard sans-serif font.

Susan J. Mack